

REMARKS

Claims 1-102 are currently pending in this application. The Examiner has required, in the Office Action, a restriction of the pending claims to one of the particular claim groups set forth in that document.

Applicants wish to first respond by thanking Primary Examiner Susan Ungar, Supervisory Patent Examiner Anthony Caputa and Examiner Jim Housel for the courtesies extended during the telephone interview of October 31, 2003 with Applicants' undersigned representative. During that telephone interview, the outstanding Restriction Requirement was discussed. In particular, the Examiners explained that, where different invention groups are joined by "linking claims" (for example, Groups 1(A)-4(H) and 5-12), the Restriction Requirement among those linked groups would be withdrawn upon allowance of the linking claims. The Examiners assured the undersigned that, upon withdrawal of the Restriction Requirement, the linked claim groups will be examined in considered in their full scope and entirety.

Based on the Examiners' representation, Applicants hereby provisionally elect (with traverse) to prosecute the claims of invention Group 1, directed to *in situ* methods for identifying and/or diagnosing diseased cells and tissue where the disease is associated with abnormal CAP43 expression. In addition, Applicants also provisionally elect (again, with traverse) the particular disease of: (F) melanoma.

The foregoing election is made here in order to be fully responsive to the Requirement for Restriction. However, Applicants respectfully traverse the Requirement for Restriction and reserve the right to petition there from under 37 C.F.R. 1.144. In particular, Applicants note that the Office Action indicates that elected claim Group 1 encompasses claims 1, 3-7, 9-11 and 25-35. However, pending claims 12, 36 and 37 are also directed and/or encompass *in situ* methods for identifying and/or diagnosing diseased cells and tissue where the disease is associated with abnormal CAP43 expression. In particular, pending claim 37 (which depends directly from claim 25) specifies embodiments where the disease is granuloma.¹ Dependent claims 12 and 36 (which

¹ Applicants wish to respectfully point out that claim 11, which is listed in the Office Action as being part of invention Group 1, also specifies embodiments where the disease is granuloma.

depend directly from claim 1 and 25, respectively) specify embodiments where the disease is atherosclerosis. Moreover, claims 51-52 specify methods for identifying a cancer cell or tissue by detecting elevated levels of a CAP43 gene product. As such, these claims are also directed to and/or encompass *in situ* methods for identifying or diagnosing diseased cells and tissue where the disease is associated with elevated CAP43 expression. For all of the foregoing reasons, Applicants respectfully submit that claims 1, 3-7, 9-12, 25-37 and 51-52 are in fact all part of elected invention Group 1 and should be examined together in this application.

The Office Action also indicates that invention Groups 1(A)-4(H) and 5-12 are linked, *e.g.*, at least by claims 1, 13, 25, 38, and 51. Accordingly, it is understood that upon a finding that one or more of such linking claims is(are) allowable, the Restriction Requirement as to these groups will be withdrawn and that all of the claims in Groups 1(A)-4(H) and 5-12 will be examined together in this application. Applicants note that the Office Action only mentions claims 1-38 and 49-50 as belonging to one or more of these invention groups. Indeed, claims 39-48 and 51-58 are not mentioned *anywhere* in the Examiner's Restriction Requirement. However, *all* of these claims are directed to methods for diagnosing and/or identifying diseased cells and tissues, by detecting elevated expression (*in situ* and/or *in vivo*) of CAP43 nucleic acids and/or proteins. Hence, claims 1-58 are in fact all linked by one or more common features and should be examined together in this application.

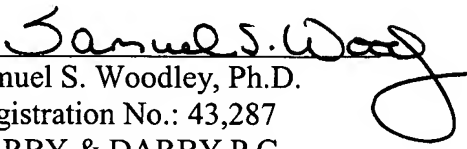
CONCLUSION

For all of the foregoing reasons, Applicants respectfully submit that the Restriction Requirement should be withdrawn and that all of the pending claims should be examined together in this Application. Alternatively, however, should the Examiner still maintain that a Restriction of the pending claims is possible, Applicants submit that the Restriction as to claims 1-58 should be

withdrawn and that the claims should be examined together as the elected claim group of this application.

Respectfully submitted,

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